

Serial No. 09/252,485
Page 9 of 11

RECEIVED
CENTRAL FAX CENTER

JAN 09 2007

REMARKS

This communication is intended as a full and complete response to the final Office Action mailed November 17, 2006. In the Office Action, the Examiner notes that Claims 42, 43, 46-48, 50, 51, 53, 54, 57, 60-64, 74 and 77-79 are pending of which claims 42, 43, 46-48, 50, 51, 53, 54, 57, 60-64 and 74 are allowed and claims 77-79 are rejected. By this response, Applicants have cancelled claim 77 and amended claims 78 and 79.

In view of the foregoing amendments and the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

REJECTIONS

35 U.S.C. §103

Claims 77-79

The Examiner has rejected claims 77-79 under 35 U.S.C. §103(a) as being unpatentable over Arai (of record) in view of Wasilewski (of record) and further in view of Ryu (of record). Applicants respectfully traverse the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible to focus either on the "gist" or "core" of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416, 420 (Fed. Cir. 1986) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter

Serial No. 09/252,485
Page 10 of 11

claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The combination of Arai, Wasilewski and Ryu fails to teach or suggest Applicant's invention as a whole.

Arai discloses a television apparatus with picture-in-picture capabilities. Arai failed to disclose many aspects of the present invention including wherein at least one of the tuners and at least one of the audio decompressors are located on an upgrade card inserted into an existing set top terminal. Wasilewski discloses multiplexing a plurality of television signals for transmission to a plurality of locations. Ryu discloses selection of sound mode depending on the selected channel.

Applicants respectfully submit that the combination of Arai, Wasilewski and Ryu do not teach or suggest all of the limitations of amended independent claims 78 and 79. Therefore, the combined references fail to teach or suggest Applicant's invention as a whole.

Therefore, because not all the limitations of claims 78 and 79 are disclosed, taught or suggested, the claims are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. For at least the above reasons, Applicants submit that independent claims 78 and 79 are not obvious and fully satisfy the requirements of 35 U.S.C. § 103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejection be withdrawn.

ALLOWABLE SUBJECT MATTER

Applicants thank the Examiner for the allowance of claims 42, 43, 46-48, 50-51, 53-54, 57, 60-64, and 74.

CONCLUSION

Thus, Applicants submit that claims 77-79 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.


If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested

Serial No. 09/252,485
Page 11 of 11

that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 1/9/07


Eamon J. Wall
Registration No. 39,414
Attorney for Applicants

PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808